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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,902	04/09/2004	Peter Leonard Hutchison	4046/019	2437
23440 7590 12/10/2009 GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 10016-0601				
EXAMINER				
TOOMER, CEPHIA D				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,902

Applicant(s)

HUTCHISON, PETER LEONARD

Examiner

Cephia D. Toomer

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 14, 2009 has been entered.
2. This office action is in response to the amendment filed September 14, 2009 in which claims 1, 19 and 20 were amended.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
2. Claims 1, 2, 8, 11, and 18-20 rejected under 35 U.S.C. 102(b) as being anticipated by Owens (US 6,129,774).

Owens teaches a clean airflow catalyst comprising a container made of aluminum wherein the container defines a flow path through which the fuel flows. The container holds a plurality of pellets or bullets made of lead, tin, antimony, zinc and nickel (see abstract; col. 2, lines 14-15, 36-39). Owens teaches that the container comprises a hollow metal cylindrical wall having an internal cavity defining a flow path. The wall has internal threads and at opposite ends to which two identical caps are screwed. Each of the caps comprises a head with an opening formed there through and a cylindrical cap wall with threads to be screwed to the threads of the cylindrical member. At each cap is a screen inwardly secured, and between the screens is the plurality of the pellets or bullets (see Fig 1 and col. 2, lines 14-28).

It should be noted that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Accordingly, Owen teaching all the material limitations of the claims anticipates the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 9, 10 and 12-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Owens (US 6,129,774).

Owens has been discussed above. Owens teaches the limitations of the claims other than the differences that are discussed below.

With respect to the limitations of claim 3, Owen does not specifically teach that the container is formed of steel. However, he teaches that the container may be made of a material other than aluminum (see col. 5, lines 55-57).

It would have been obvious to one of ordinary skill in the art to form the container from a material such as steel because Owens teaches that the container is formed from a metal material and that the material may be a material other than aluminum.

With respect to the limitations of claims 9 and 10, Owens does not specifically teach that the soot removal agent is coated on a substrate. However, he teaches that the aluminum container may function as part of the catalyst and this teaching suggests the substrate and coating.

With respect to the limitations of claims 12 and 13, Owens teaches that the catalyst comprises bullets or pellets, i.e., ingots. He teaches a plurality of Applicant's claimed single body ingot, pellet or bullet; however, it is well settled that a duplication of parts, such as the ingot or pellets, renders obvious a single ingot or pellet.

With respect to claims 14-16, Owens teaches that the container contains caps on both ends of the container and that these caps comprise a head with an opening formed there through and a cylindrical cap wall with threads to be screwed to the threads of the cylindrical member. This teaching suggests the at least one end of the container being open, partially closed and partially closed by an inwardly directed flange.

With respect to claim 17 and the shape of the container, it is well settled that the configuration of a container is a matter of choice that a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container is significant.

Response to Arguments

5. Applicant's arguments filed September 14, 2009 have been fully considered but they are not persuasive. Applicant argues that the claims are allowable over Owen because Applicant has shown commercial success of the invention as embodied in the claims.

6. Applicant's arguments, the declaration submitted by Mr. Hutchinson, the additional declarations and the Exhibits have been considered.

Applicant is claiming a generic flue cleaner. The product sold as "SmartBurn" is a very specific container wherein the sacrificial material is a known product. It is not clear to the examiner that the product that is being sold is the product of the claims.

With respect to Applicant's gross sales figures, gross sale figures do not show commercial success absent evidence as to market share. Are there not other flue cleaners on the market and what are their shares of the market?

In considering Applicant's evidence of commercial success it is not clear if Applicant's alleged success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention.

Claims 4-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach or suggest that the opening is closed by a closure formed of a material which will be consumed slowly upon the flue cleaner being placed in a fire; that the soot removal agent is encased within the enclosed container within a settable composition (sawdust and a binding agent) which will harden once being introduced into the enclosed container.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldaria can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Cephia D. Toomer/

Primary Examiner

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